

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number: 08215-549001
<p>I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.</p> <p>_____</p> <p>Date of Deposit</p> <p>_____</p> <p>Signature</p> <p>_____</p> <p>Typed or Printed Name of Person Signing Certificate</p>	Application Number 10/656,881	Filed September 8, 2003
	First Named Inventor Augusto D. Hernandez et al.	
	Art Unit 2859	Examiner Richard A. Smith
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record <u>45,653</u> (Reg. No.)</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> </div> <div style="width: 45%; text-align: right;"> <p>_____ /Diana DiBerardino/ Signature</p> <p>_____ Diana DiBerardino Typed or printed name</p> <p>_____ (202) 783-5070 Telephone number</p> <p>_____ May 2, 2007 Date</p> </div> </div> <p style="font-size: small; margin-top: 20px;">NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p>		
<input type="checkbox"/> Total of 6 forms are submitted.		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Augusto D. Hernandez et al. Art Unit : 2859
Serial No. : 10/656,881 Examiner : Richard A. Smith
Filed : September 8, 2003 Conf. No. : 8107
Title : STEP VOLTAGE REGULATOR POLYMER POSITION INDICATOR WITH
NON-LINEAR DRIVE MECHANISM

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005, New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of Examiners is requested because the rejections of record are clearly not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 1-28 are pending, with claim 1 being independent. Claims 7-22, 26, and 27 have been allowed. Claims 1-6, 23, 24, and 28 have been rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 3,092,071 ("Simpson") in view of U.S. Patent No. 5,506,791 ("Hungerford"). Claim 25 has been rejected as being obvious over Simpson and Hungerford in view of U.S. Patent No. 2,800,248 ("Truesdell").

Claims 1-6, 23, 24, and 28

Applicant respectfully disagrees with, and hereby asks the panel to review and reverse, the rejection of these claims. In particular, Applicant requests withdrawal of this rejection because neither Simpson, Hungerford, nor any proper combination of these references describes or suggests a one-piece clear polymer cover enclosing a position indicator display and mechanism in a polymer housing, as recited in claim 1. Furthermore, one of ordinary skill in the art would not have been motivated to modify Simpson in the manner suggested by the Examiner.

In Simpson, a device 10 has a movable part 11 that may occupy a variety of positions. See Simpson at col. 2, lines 57-59 and Fig. 1. A remote indicator 20, which includes a housing 21 and a pointer 23 mounted on the dial face 22 to display the movement of the movable part 11, displays the movement of the movable part 11 on a dial face 22. See Simpson at col. 3, lines 3-9 and Fig. 2. However, Simpson does not disclose a cover of any sort that encloses the pointer 23 and the dial face 22 in the housing 21. Moreover, Simpson does not disclose a polymer housing. Realizing these deficiencies, the Examiner relies on Hungerford to show a polymer housing and a one-piece clear polymer cover, suggesting that it would have been obvious to modify Simpson with the teachings of Hungerford. Applicant disagrees for the reasons discussed below.

Hungerford relates to a fluid flow monitoring apparatus. See Hungerford at col. 1, lines 18-20. Hungerford's apparatus measures fluid flow-related variables from multiple types of fluid-flow sensors that are attached to a case 1. See Hungerford at col. 1, lines 20-22. The apparatus includes the case 1 that houses the electronic and mechanical components of the apparatus, including an operating panel 2 that includes a keypad 3, a liquid crystal display 4, and push buttons 5. See Hungerford at col. 6, lines 25-27 and lines 32-36 and Figs. 1 and 2. The case 1 includes a transparent door 6 that provides additional protection for the operating panel 2 when the door 6 is closed. See Hungerford at col. 6, lines 41-43 and Figs. 1 and 2. However, Hungerford's door 6 does not enclose a position indicator display and mechanism in a polymer housing, as recited in claim 1. Rather, Hungerford's door 6 covers the operating panel 2, which is not a position indicator display and mechanism.

Moreover, there is no suggestion in the cited references to modify the housing 21 of Simpson to include the door 6 of Hungerford. The Examiner states:

[I]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify the housing for the position indicator, taught by Simpson, Jr. et al., by making the housing a polymer housing, and adding a one piece clear polymer cover, a hinge and a latch to the housing, as suggested by Hungerford et al., in order to provide impact resistance, resistance to stresses from mounting and harsh conditions, dust resistant and corrosion resistant, as taught by Hungerford et al., and to allow easier servicing of the components of the position indicator when needed.

See Final Office Action of Feb. 2, 2007 at page 3, lines 13-19.

The benefits enumerated above do not provide the requisite motivation for modifying Simpson with Hungerford. First, Simpson lacks a cover that encloses the pointer 23 and the dial face 22 in the housing 21. Thus, Simpson implicitly teaches away from the use of a cover.

Second, Hungerford does not use the door 6 to achieve the benefits enumerated above. Rather, Hungerford achieves dust resistance and corrosion resistance by sealing the case 1. See Hungerford at col. 6, lines 45-48. Indeed, Hungerford's case 1 remains sealed even when the door 6 is open. See Hungerford at col. 6, lines 45-48. Furthermore, the door 6 does not provide impact resistance or resistance to mounting stresses. Rather, the case 1 provides these benefits. See Hungerford at col. 6, lines 27-31. Moreover, there is no indication in Hungerford that the door 6 allows easier servicing of the fluid-flow monitoring apparatus. Because Hungerford does not describe or suggest a door that provides such advantages, one of ordinary skill in the art would not be motivated to modify Simpson's housing 21 with Hungerford's door.

Third, the benefits Hungerford describes for using the door 6 merely provide motivation for using the door 6 in Hungerford's apparatus and do not provide the requisite motivation for adding a cover to Simpson's device. Hungerford explains that Hungerford's door 6 provides some addition minimal protection for components within the case 1 because the case 1 is used in an extreme environment. See Hungerford at col. 8, lines 13-15 and Fig. 6 (showing Hungerford's apparatus mounted in a sewer manhole). However, because there is no indication that Simpson's device is used in such an extreme environment or that Simpson's device should include a cover, there is no suggestion in either Simpson or Hungerford to add Hungerford's door 6 to Simpson's device.

For at least these reasons, claim 1 is allowable over any proper combination of Simpson and Hungerford. Dependent claims 2-6, 23, 24, and 28 are allowable for at least the reasons that claim 1 is allowable, and for containing allowable subject matter in their own right. For example, claim 2 recites "a hinge and a hand-operable latches that secure the one-piece clear polymer cover to the polymer housing such that the one-piece clear polymer cover can be opened without the use of tools." As discussed above, the housing 21 in Simpson is not a polymer housing, nor does Simpson show "a one-piece clear polymer cover enclosing the position indicator display and mechanism in the polymer housing." Thus, Simpson also fails to describe

or suggest a hinge or latches that would secure such a polymer cover. Hungerford's door 6 is "hingedly secured at 6A to one side of the front case portion, and is retained in a closed position by a pair of stainless steel lockable latches 6B at the opposite side." See Hungerford at col. 6, lines 38-41. However, there is no indication that the latches 6B are hand-operable latches that secure the door 6 to the case 1 such that the door 6 can be opened without the use of tools. Moreover, even if the latches 6B could be equated with such a hand-operable latch, modifying Simpson's housing 21 to include the latches 6B, in addition to modifying the housing 21 to be a polymer housing and adding a one-piece polymer cover to enclose the pointer 23 in the housing 21, would constitute a substantial reconstruction and redesign of the housing 21. Accordingly, such a modification of the housing 21 would not have been obvious. See MPEP § 2143.01 VI.

In another example, claim 3 recites "the hinge includes a first portion that is integrated with the polymer housing and a second portion that is integrated with the one-piece clear polymer cover." As discussed above, Hungerford's door 6 is hingedly secured to the case 1. However, there is no indication that Hungerford includes a hinge that includes a first portion that is integrated with the case 1 and a second portion that is integrated with the door 6.

For at least these additional reasons, the rejections of dependent claims 2 and 3 should be reversed.

Claim 25

Claim 25, which depends from claim 1, was rejected as being obvious over Simpson and Hungerford in further view of Truesdell. Applicant requests reversal of this rejection for the following reasons.

As discussed above, claim 1 was rejected as being obvious over Simpson in view of Hungerford. Moreover, Truesdell fails to remedy the failure of Simpson and Hungerford to describe or suggest "a one-piece clear polymer cover enclosing the position indicator display and mechanism in the polymer housing." In Truesdell, an instrument housing includes a receptacle 7 and a cover 8 that mates with the receptacle 7. However, there is no suggestion that the cover 8 is a one-piece clear polymer cover or that the receptacle 7 is a polymer housing. Accordingly, claim 1 is allowable over any proper combination of Simpson, Hungerford, and Truesdell, and

Applicant : Augusto D. Hernandez et al.
Serial No. : 10/656,881
Filed : September 8, 2003
Page : 5

Attorney's Docket No. 08215-549001

claim 25 is allowable for at least the reasons that claim 1 is allowable and for containing allowable subject matter in its own right.

In conclusion, Applicant requests that the rejections of claims 1-6, 23-25, and 28 be reversed.

The fee in the amount of \$500 for the appeal fee is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: May 2, 2007

/Diana DiBerardino/

Diana DiBerardino

Reg. No. 45,653

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331

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